

PATENT

Attorney Docket No. MYCOLOGX-04875

## REMARKS

Claims 1-29 were originally filed in the present application. In response to a Restriction Requirement mailed October 2, 2002, Applicants elected to prosecute Claims 12 - 29 of Group III and canceled Claims 1-11. Thus, Claims 12-29 are currently pending.

Applicants assert that copies of all 71 references listed on Form 1449 were submitted in three-ring binder in support of the Information Disclosure Statement filed on October 1, 2001, and received by the PTO on October 11, 2001. Applicants encourage the Examiner to try to locate the originally-submitted references. However, in the event, that a second effort by the Examiner fails, Applicants encourage the Examiner to contact their representative for resubmission of these references so that they may be duly considered.

In addition, Applicants thank the Examiner for noting that "[t]he presently claimed method of determining if a compound is a microbial ketol-isomerase inhibitor with nitro blue tetrazolium chloride using the pathway shown in Fig. 2 is not fairly taught or suggested by the references of record."<sup>1</sup>

In the Office Action mailed January 24, 2003, a single rejection was lodged:

Claims 12-29 stand rejected under 35 U.S.C. § 112 second paragraph, as allegedly being indefinite.

Applicants hereby amend Claims 12, 17, 19 and 28, and have introduced new Claims 30-40, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s). These amendments do not introduce new matter. In addition, none of the amendments to the Claims is intended to narrow the scope of any of the amended Claims within the meaning of *Festo*.<sup>2</sup>

<sup>1</sup> Office Action, page 3.

<sup>2</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000).

*PATENT*  
Attorney Docket No. MYCOLOGX-04875

AMENDED CLAIMS ARE DEFINITE

The Examiner rejected Claims 12-29, under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences."<sup>3</sup> Applicants must respectfully disagree. Nonetheless, Applicants have amended Claims 12, 17, 19 and 28, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute originally filed and/or similar Claims in the future.

The Examiner notes in Claim 12, line 1 the phrase "the identification" lacks antecedent basis. In addition, the Examiner notes that the preamble of Claim 12 among other instances, improperly recites a compound having "the ability to," and suggests a suitable replacement phrase. Applicants gratefully acknowledge the Examiner's suggestion and have amended the preamble of Claim 12 to recite "a method for identification of a compound which inhibits microbial ketol-isomerase activity..." Applicants have made similar amendments to step g of Claim 12, and Claim 17. Moreover, the Examiner indicates that the use of the phrase "is capable of" in Claim 12, step c and elsewhere is improper. Accordingly, Applicants have amended step c of Claim 12, step e of Claim 12, step j of Claim 19, and step l of Claim 19 to recite "suitable for."

Additionally, the Examiner states "in claim 19, it is unclear as to how the microbial isomerase differs from the second isomerase." Applicants respectfully disagree and assert that step h of Claim 19 clearly indicates that the second isomerase is either a plant or an animal ketol-isomerase. However, to improve the clarity and brevity of Claim 19, Applicants have amended the preamble to recite simply "the method of Claim 12, further comprising the steps of..." Also, the Examiner has indicated that the recitation "said animal" in Claim 20 lacks antecedent basis. Applicants again respectfully disagree and assert that the antecedent basis for said animal lies in step h of Claim 19, from which Claim 20 depends. Other amendments to Claims 12, 17, 19 and 28, have been made by Applicants, to improve the readability of the claims. Applicants assert that the amended claims are definite and respectfully request that this rejection be withdrawn.

<sup>3</sup> Office Action, page 2.

PATENT

Attorney Docket No. MYCOLOGX-04875

## NEW CLAIMS

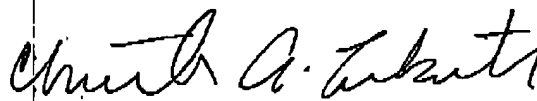
Applicants have also introduced new Claims 30-40, to encompass additional embodiments of the present invention directed to the detection of compounds inhibiting ketol-isomerase activity (*e.g.*, Group III). In particular, new Claims 30-36 and Claims 37-40 are directed to methods and kits respectively, for the detection of ketol-isomerase inhibitors. Support for the new claims can be found in the Specification as filed. Specifically, support for the term "a sample comprising a ketol-isomerase" can be found in original Claim 4 which reads "wherein said sample comprises a ketol-isomerase selected from the group consisting of fungal ketal-isomerases, bacterial ketol-isomerases, animal ketol-isomerases and plant ketol-isomerases." In addition, support for the term "a redox-sensitive chromogenic substrate" can be found in the Description which reads "the  $\beta$ -NADH produced in this secondary reaction is then quantitated using a "redox-sensitive chromogenic substrate" (Specification, at page 41, lines 10-12). Similarly, support for the phrase "measuring is accomplished by spectrophotometric analysis" is found in the Description which reads "nitro BT is reduced in the presence of  $\beta$ -NADH and phenazine methosulfate (PMS) to yield a compound that is measurable at 585 nm wavelength, and is readily quantitated using standard colorimetric spectrophotometry" (Specification, at page 41, lines 14-16). Lastly, support for the phrase "the group consisting of a crude cell lysate, a purified ketol-isomerase and a recombinant ketol-isomerase" can be found in original Claim 5 (*i.e.*, lysate), Claim 7 (*i.e.*, purified ketol-isomerase), and Claim 8 (*i.e.*, recombinant ketol-isomerase). Thus, Applicants respectfully request allowance of new Claims 30-40.

**PATENT**

Attorney Docket No. MYCOLOGX-04875

**CONCLUSION**

Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejection and, therefore, respectfully request that this ground for rejection be withdrawn. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

Dated: April 15, 2003

Christine A. Lekutis  
Registration No. 51,934

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
415.904.6500